

**IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

Paul Bryan,

Petitioner

v.

United States Patent and Trademark Office,

Respondent

NOTICE OF APPEAL

To: Director of the US Patent and Trademark Office
Office of the Solicitor
Mail Stop 8
Alexandria, VA 22313-1450

Clerk
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

Notice is given that the Petitioner, Paul Bryan, hereby appeals to the United States Court of Appeals for the Federal Circuit from the April 9, 2008, Decision of the Patent and Trademark Office Board of Appeals and Interferences with respect to Appeal No. 2007-1590 and Application No. 09/871,349.

If any fees are required by the United States Patent and Trademark Office they should be charged to Deposit Account No. 18-1167.

Three copies of this Notice of Appeal, along with a docketing fee of \$450.00 are being served on the Clerk for the United States Court of Appeals for the Federal Circuit.

This the 30 day of May, 2008.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the enclosed Notice of Appeal is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10, **EXPRESS MAIL CERTIFICATE LABEL NO. EV 643634214 US**, on the date indicated below and is addressed to Director of the US Patent and Trademark Office, Office of the Solicitor, Mail Stop 8, Alexandria, VA 22313-1450

SIGNATURE 

DATE: May 30, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL J. BRYAN

Appeal 2007-1590
Application 09/871,349
Technology Center 3700

Decided: April 9, 2008

Before JENNIFER D. BAHR, ROBERT E. NAPPI, and DAVID B. WALKER
Administrative Patent Judges.

NAPPI, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) of the final rejection of claims 1 through 11, and 13 through 15. Claim 12 has been cancelled. We affirm the Examiner's decision.

INVENTION

The invention is directed to a board game which has a game board, tokens, dice and cards. See page 2 of Appellant's Specification. Claim 1 is representative of the invention and reproduced below:

1. A game board and game, comprising:
 - (a) a game board having a starting area, a network of irregular paths that lead from the starting area; and a central performing stage located generally centrally on the game board and connected to at least one segment of the network of paths;
 - (b) the network of paths including a series of segments wherein each segment is broken down into increments and wherein at least some of the increments include indicia formed thereon that dictate an action for landing on a particular increment;
 - (c) a series of tokens provided with the game board wherein a token may be assigned to one player and during the course of a game the token is advanced along one or more of the segments of the network of paths;
 - (d) at least one die that is used to determine the number of increments that a player's token can be advanced during the course of the game;
 - (e) a supply of money that during the course of the game is distributed to the players;
 - (f) a deck of "Consequence" cards that are keyed to certain increments on the network of paths, each "Consequence" card having indicia thereon that sets forth a consequence and wherein a player landing on an increment that calls for drawing a consequence card must comply with the directive set forth on the drawn consequence card;
 - (g) a deck of "Band Member" cards with the deck being divided into a series of groups with each group of "Band Member" cards designating members of a band;
 - (h) a series of "Band Equipment" cards with each card designating band equipment; and
 - (i) wherein the object of the game is for each player to advance his or her token along the network of paths and reaches the central stage with a predetermined number of one group of "Band Member" cards and a "Band Equipment" card.

REFERENCES

Elrod	US 4,998,736	Mar. 12, 1991
Hunsberger	US 6,279,908 B1	Aug. 28, 2001

REJECTIONS AT ISSUE

Claims 1 through 5, 7 through 11, 13, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elrod.¹ The Examiner's rejection is set forth on pages 5 through 7 of the Answer; the rejection of claim 14 is on pages 7 and 8 of the Answer.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Elrod and Hunsberger.² The Examiner's rejection is set forth on page 7 of the Answer.

Throughout the opinion, we make reference to the Brief (received March 28, 2005), Reply Brief (received August 15, 2005) and the Answer (mailed August 1, 2006) for the respective details thereof.

ISSUES

¹ We note that the Examiner's statement of the rejection also identifies *Ex. Parte Breslow*, *In re Ngai*, and *In re Gulack* as prior art applied in the rejection. As these cases are not relied upon to present evidence of knowledge in the art, we have not recited them in the statement of the rejection. It appears that the Examiner is confused about how to identify case law. These cases provide guidance as to how non functional descriptive material is to be considered during Examination.

² See note 1.

A) Whether Appellant has shown that the Examiner erred in rejecting claims 1 through 5, 7 through 11, 13, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Elrod. We note that Appellant's arguments, on pages 5 through 17 of the Brief, separately address claims 1, 11, and 14. Thus in accordance with 37 C.F.R. § 41.37(c)(1)(vii), we select claim 1 to be representative of the group of claims 1 through 5, 7 through 10 and 15, we select claim 11 to be representative of the group of claims 11 and 13, and we consider claim 14 alone.³

B) Whether Appellant has shown that the Examiner erred in rejecting claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Elrod and Hunsberger.

PRINCIPLES OF LAW

Office personnel must rely on Appellant's disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, (emphasis in original) (citing *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989)).

³ We note that on page 6 of the Reply Brief, Appellant state that the claims were argued in 5 groups, and that the Examiner did not respond to each of these groups. We disagree with this statement as a) Appellant did not separately argue claim 13 in accordance with 37 C.F.R. § 41.37(c)(1)(vii); thus claim 13 is grouped with claim 11 and there are four (4) groups; and b) the Examiner did address each of the four groups on pages 5 through 7 of the Answer.

However, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, (Fed. Cir. 2004) and our recent final decision in *Ex parte Curry*, 2005-0509 (BPAI 2007), 84 USPQ2d 1272 (Affirmed, Rule 36, Fed. Cir., slip op. 06-1003, June 2006).

ANALYSIS

Claims 1 through 5, 7 through 10 and 15.

Appellant's arguments have not persuaded us that the Examiner erred in rejecting claims 1 through 5, 7 through 10 and 15. On page 6 of the Brief, Appellant argues that the Examiner's rejection is in error as it combines legal authority with prior art and as such the rejection should be reversed. This argument has not persuaded us of reversible error by the Examiner. We agree with Appellant that including citations to case law in the statement of the rejection is unusual. However, we disagree with Appellant's assertion that this constitutes reversible error. Appellant has cited no legal authority to support that such an action by the Examiner constitutes reversible error. Further, it is clear from the record that the Examiner used these cases as guidance for considering non functional descriptive material. As discussed *infra*, we consider these cases to be relevant to the analysis of the Appellant's claims. Thus, Appellant's arguments concerning the citation of case law in the statement of the rejection have not persuaded us of error.

On page 6 of the Brief and pages 4 and 5 of the Reply Brief, Appellant argues that the Examiner's rejection of claim 1 is in error as "Claim 1 Includes a

Third Deck of Band Equipment Cards Not Found in Elrod and Not Even Addressed By the Examiner.” Appellant argues on pages 6 and 7 of the Brief, that claim 1 calls for three decks of cards, and the Examiner’s rejection only addressed two decks of cards. Further, on pages 7 and 8 of the Brief and 4 through 6 of the Reply Brief, Appellant argues that the Examiner misconstrued the “Band Member” cards by failing to give patentable weight to the recitation that the band member cards are a series of groups with each group of “Band Member” cards designating members of a band.

In response, the Examiner states on page 9 of the Answer, that “[t]he only difference between appellant’s game (cards, game path) and Elrod[’s] game (cards, game path) resides in [the] meaning and information conveyed by the printed matter and would not be [a] patentable difference.” Further, on page 10 of the Answer, the Examiner states:

Applicant’s arguments that Elrod does not provide a third deck (?) of cards are not persuasive. Elrod supplies a large number of cards (7:38-10:16) that can be divided into a large number of decks as long as each deck has plurality of cards. It may be noted that a deck only means a stack of cards.

We agree with the Examiner’s interpretation of the claim term “deck” of cards and with the Examiner’s determination that the differences between the claimed elements of a game and the prior art lie in the information printed on the board and cards. Claim 1 recites “a deck of ‘Consequence’ cards ... a deck of ‘Band Member’ cards,” and “a series of ‘Band Equipment’ cards.” Thus, initially we note that claim 1 does not recite three decks of cards, but two decks and one series of cards. Nonetheless, Appellant’s Specification provides no definition of either term “deck” or “series” of cards. The Examiner has interpreted these terms

to mean a stack of a plurality of cards.⁴ Appellant has not challenged this by providing an alternative meaning of the term, but rather has asserted that Elrod only teaches two decks. While we agree that Elrod identifies that the game includes two decks, this does not however mean that the Decks of Elrod could not also be characterized as more than two decks (i.e., in identifying the decks of cards, the cards could be separated out into numerous stacks to form multiple decks). We note that the claim identifies the two decks and one series by identifiers (titles) in quotes, e.g. “Consequence,” “Band Member” and “Band Equipment.” We consider these titles merely to identify the deck or series of cards being claimed and do not consider them to add any patentable weight to the claim (i.e., we consider these titles to do no more than if the claim recited a first deck a second deck and a third deck).

Claim 1 further identifies that deck of “Band Member” cards as being “divided into a series of groups with each group of ‘Band Member’ cards designating members of a band.” This limitation is a description of the indicia printed on the card. We find no claimed or functional relationship between the card or other elements claimed and the indicia printed on the card. As such, we consider the limitations identifying the information printed on the Band Member card to be directed to non functional descriptive material, and as such not to differentiate the claim from the prior art. Contrary to Appellant’s assertion in paragraph 8 of Paul Bryan’s March 24, 2005 Declaration, it is immaterial that the information on the card may be functionally related to itself (i.e., the series of groups limitation), as this limitation is describing the printed matter’s relation to itself and not the card. Further, the claim recites no limitations directed to what the

⁴ In so finding the Examiner has implicitly found that the term “deck” does not imply that the cards have a relationship with each other.

series of groups represents, any group of symbols can be ordered into a series of groups. Further, it is of no consequence that the information on the card may be functionally related to the method of playing the game, as claim 1 is an apparatus claim and recites no functional method steps of playing the game which functionally use the indicia.

Claim 1 also recited “a series of ‘Band Equipment’ cards with each card designating band equipment.” Similar to the limitation directed to “Band Member” cards, this limitation merely recites a description of the indicia printed on the card. We find no functional relationship between the card or other elements of the claim and the indicia printed on the card.

We find that Elrod teaches that there is a plurality of cards used in the game. Elrod identifies that the cards may be divided into two decks (sets) titled, “Challenge” and “Rescue.” Within the set of cards titled “Challenge” there are groups of cards characterized as “Self Challenge” cards, “Challenge an Opponent” cards and other cards. See col. 8, ll. 34-col. 10, ll. 16, col. 11. ll. 50. Within the set of cards titled “Rescue” there are groups of cards characterized as “Rescue Me” cards, “Block A” cards, and “Name A” cards. Any of these groups of cards can be considered a deck of cards. That they contain different indicia than the claimed “Band Equipment” and “Band Member” cards does not distinguish the claimed invention from Elrod. As discussed above, these differences lie in the matter printed on the card and do not functionally relate to the cards, and as such will not distinguish the claimed cards from those in the prior art. Thus, Appellant’s arguments have not persuaded us that the Examiner erred in finding that Elrod teaches three decks or erred in failing to give patentable weight to the recitation of “Band Equipment” and “Band Member” cards.

Further, we are not persuaded by Appellant's arguments on pages 9 through 11 of the Brief that the Examiner erred in not considering the limitations directed to the paths on the board. Claim 1 recites a game board having a starting area, and a central stage with a network or irregular paths leading from one location to the other. The claim further recites that the paths include segments that are broken into increments which include indicia that dictate action when landing on the indicia. Appellant's Specification does not identify the details of the board's construction; however, as known in the art, the board in board games is made of a flat material that has indicia printed thereon and the board provides support for game pieces. We consider the indicia, identifying the starting area, central stage, and the paths (including the segments, and increments with directions to be followed when landing on the increment) to be non-functional descriptive material or printed matter. As identified *supra* non-functional descriptive material will not differentiate a claimed invention from the prior art. Appellant argues, on pages 9 and 10 of the Brief and paragraph 7 of Paul Bryan's March 24, 2005 Declaration that the paths functionally relate to the game board as they define a path that the player tokens move during the game. However, we disagree. Initially, we note that claim 1 is an apparatus claim, not a method claim. We do not find that the indicia functionally relates to the board or the other elements of the claim. In *In re Gulack*, the court found that the indicia on Gulack's band related to the endless nature of Gulack's band. *In re Gulack*, 703 F.2d. 1381, 1386-87 (Fed. Cir. 1983). We find no such interrelationship between Appellant's board and the indicia on the board. Rather, we find that the nature of the information printed on the board to be more akin to the sheet of instructions discussed in *In re Ngai*, where the court held that "the printed matter [the instruction sheet] in no way depends upon the kit, and the kit does not depend upon the printed matter." *In re Ngai*, 367 F.3d at 1339.

Here, the indicia printed on the board in no way relates to the other elements of the claim (the tokens, the die, the money, the cards); rather, the board merely provides guidance (instructions) as to how the elements are to be used together when the game is played. Thus, we agree with the Examiner that the claimed features of the board constitute non functional descriptive material.

As the paths on the board represent non functional descriptive material, the limitations directed to these paths will not distinguish the claimed game board from the game board in Elrod. Nonetheless, even if the limitations were considered to be functional, we find that Elrod teaches the claimed starting area, central stage, and the paths including the segments, and increments with directions to be followed when landing on the increment. Elrod teaches a starting area; see increment 1 in figure 1. Elrod teaches several “stages”, “Stage 1,” “Stage 2” ... “Stage 5”, and “Final Stage.” See figure 1. Elrod teaches a segmented path broken up into increments numbers 2-118. Note this path represents several paths to the final stage, as the token may traverse from increment 13 to 25 by crossing “Stage 1” or by traversing increments 14-24. There are similar paths associated with the other numbered stages, and there is the path made up of increments 50a-55a. See figure 1. Elrod teaches that the increments of the paths have instructions to be followed when a token lands on them. Col. 1, ll. 8-9.

For the above reasons, Appellant’s arguments have not persuaded us of error in the Examiner’s rejection of independent claim 1. As claims 2 through 5, 7 through 10 and 15 are grouped with claim 1, we sustain the Examiner’s rejection of claims 1 through 5, 7 through 10 and 15.

Claims 11 and 13.

Appellant argues on pages 11 and 13 of the Brief that the Examiner's rejection is in error as the Examiner gave no patentable weight to the limitations directed to the "Band Member" cards. Appellant asserts that the Examiner did not apply the printed matter doctrine to claim 11.

Appellant's arguments have not persuaded us of error in the Examiner's rejection. Initially, we note the Examiner identified, on page 9 of the Answer, that the difference between the claimed invention cards, game path and the prior art resides in the meaning on the information on the cards. Thus, the Examiner did rely upon the printed matter doctrine in interpreting claim 11 and applying art to claim 11.

Claim 11 recites "A game board and game comprising: ... a second deck of cards ... the second deck of cards are "Band Member" cards and include a plurality of groups of cards with each group of cards representing a band and the members of the band." Similar, to the "Band Member" card limitation of claim 1, this limitation of claim 11 is a description of the indicia printed on the card. We find no claimed or functional relationship between the card or other elements claimed and the indicia printed on the card. As such, we consider the limitations directed to the information printed on the Band Member card to be directed to non functional descriptive material, and as such not to differentiate the claim from the prior art. As discussed above with respect to claim 1, Elrod teaches a game which makes use of at least two decks of cards. Accordingly, Appellant's arguments have not persuaded us of error in the rejection of claim 11. As claim 13 is grouped with claim 11, we sustain the Examiner's rejection of claims 11 and 13.

Claim 14.

On page 15 of the Brief, Appellant argues that the Examiner's rejection of claim 14 is in error. Appellant asserts that the Examiner erred in characterizing the limitations directed to the paths on the board as aesthetic. Further, on pages 16 and 17 of the Brief, Appellant asserts that the Examiner correctly did not apply the printed matter doctrine to claim 14, as there is a functional relationship between the paths on the board and the board. Further, Appellant argues, on page 17 of the Brief, that the Examiner offered no evidence to support the finding that it would have been obvious to modify Elrod to change the configuration of the playing path.

Appellant's arguments have not persuaded us of error in the Examiner's rejection. Initially, we note that in the statement of the rejection of claim 14, on page 8 of the Answer, the Examiner states: "The only difference between applicant's board game and the cited reference resides in the meaning and information conveyed by the printed matter and not considered as patentable subject matter." The Examiner goes on to find that the paths on the board are aesthetic in nature (as opposed to functional in nature). Thus, contrary to Appellant's assertion, the Examiner has applied the printed matter doctrine to claim 14. Claim 14 is dependent upon the board game of claim 11 and further recites that the network of paths includes an outer path, an intermediate path, a curved path, and a series of feeder paths. As discussed above, it is known in the art that the board in board games is made of a flat material that has indicia printed thereon it and the board provides support for game pieces. We consider the indicia identifying the paths to be non-functional descriptive material or printed matter. As discussed *supra*, non functional descriptive material will not differentiate a claimed invention from the prior art. Appellant argues, on page 16 of the Brief and in paragraph 7 of Paul Bryan's March 24, 2005, Declaration, that the paths functionally relate to the game board as they define a path that the player tokens

move during the game. We disagree with Appellant's assertion; claim 11 is an apparatus claim, not a method claim. As discussed above with respect to claim 1, the indicia printed on the board in no way relates to the other elements of the claim (the cards); rather, the board merely provides guidance (instructions) as to how the elements are to be used together when the game is played. Thus, we agree with the Examiner that the claimed features of the board constitute non-functional descriptive material.

As the paths on the board represent non-functional descriptive material, the limitations directed to these paths will not distinguish the claimed game board from the game board in Elrod. Accordingly, Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 14.

Claim 6

Appellant argues on page 13 of the Brief that the Rejection of claim 6 is in error for the reasons discussed with respect to claim 1. On page 14 of the Brief, Appellant argues that the Examiner's motivation, to apply the commonly used technique of color coding cards, taught by Hunsberger, to the cards of Elrod, is inconsistent with the claim language and how Elrod would have to be modified to meet the claim.

With respect to claim 6, the Examiner states on page 11 of the Answer, "that the only difference between the applicant's cards and Elrod [sic, Elrod's] cards resides in the meaning and information conveyed by the printed matter and open to interpretation."

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 6. Claim 6 is dependent upon claim 1 and further recites that the "'Band Member' cards are color coded such that each group may be distinguished

by color.” As discussed with respect to claim 1, we consider the indicia printed on the “Band Member” cards to be non-functional descriptive material. That the indicia printed on the cards may be color coded does not make the indicia functional as it does not create a non obvious relationship between the card and the indicia. As the indicia are not functionally related to the cards, the limitations directed to the indicia will not differentiate the claimed cards from the cards in the game of Elrod.

Further, even if the limitations were considered functional, Appellant’s arguments directed to the motivation to combine the references are not persuasive of error, as they assert a strict application of the motivation to combine test. On the issue of obviousness, the Supreme Court has recently stated that “the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739. Here the Examiner has found that it is well known in board games, as evidenced by Hunsberger, to color code cards used in the game. To combine such color-coding with Elrod’s game would yield the predictable result of facilitating grouping of the cards.

For the foregoing reasons, Appellant’s arguments have not persuaded us of error in the Examiner’s rejection of claim 6.

DECISION

Appeal 2007-1590
Application 09/871,349

The Examiner's decision to reject claims 1 through 11, and 13 through 15 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

KIS

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